

Claims 15-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hastings et al. (U.S. Patent No. 5,626,849), the Purina CNM Veterinary Product Guide (Published in 1994 by the Ralston Purina Company), and Nakatsu et al. (U.S. Patent No. 5,240,962). This rejection is respectfully traversed.

Hastings discloses a weight loss-promoting dietary supplement comprising hydroxycitric acid, L-carnitine, chromium, choline, inositol, gamma-linolenic acid, herbs (preferably ginkgo bilboa), and antioxidants (preferably coenzyme Q10) (abstract and claim 1). The supplement of Hastings is typically administered as a dry powder, or when mixed with a liquid, as a beverage for enteral administration (col 2, lines 32-66).

The Purina Product Guide discloses OM-Formula Canine Veterinary Diet for use in managing obesity in overweight dogs (pages 16-17). The food has the characteristics of low fat, high fiber, and reduced calories (page 16). The ingredients of the dry food include ground yellow corn, pea fiber, meat and bone meal, and vitamin supplements, including Vitamin A, as well as many other ingredients (page 17).

Nakatsu discloses that administering certain phenols regulates body weight and reduces fat in animals (col. 2, lines 38-51). It discloses that the active phenols can be administered by mixing the phenols with an animal's feed, for example "grains such as corn, sorghum, wheat, barley, oats and the like" (col. 5, lines 19-35). It discloses that trace minerals and vitamins can also be included in the feed (col. 5, lines 36-38). The specific phenol compounds are the only active weight reducing components discussed in Nakatsu.

Applicant has discovered that feeding a mammal a composition comprising L-carnitine, chromium, Vitamin A, and a source of carbohydrates selected from low glycemic index grains assists in losing weight and maintaining weight loss in the mammal (page 2, lines 11-20). Applicant has discovered that sources of carbohydrates having low glycemic indexes improve glucose metabolism, resulting in fewer abrupt rises and falls in blood glucose levels. This improved glucose metabolism causes the individual to feel more satiated, thus consuming less food, and losing weight (page 3, lines 23-27). In particular, Applicant has discovered that sorghum and barley are effective low glycemic index sources of carbohydrates for reducing weight in companion animals (page 6, lines 17 and 19).

Claims 15-24 are directed to a composition comprising an effective weight reducing amount of L-carnitine, chromium, Vitamin A, and a source of carbohydrates selected from sorghum, barley, and mixtures thereof, which composition is formulated as a solid pet food.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. M.P.E.P. § 2143, citing with approval *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

There is no motivation to combine the cited documents. It is respectfully submitted that one skilled in the art would not look to the disclosure of Hastings in order to prepare a weight reducing pet food, since Hastings is primarily directed to a composition for human consumption (see column 2, lines 32-33; although mammals are mentioned column 1, last line). Additionally, there is no experimental data in Hastings (either animal or human) demonstrating that the compositions discussed therein reduce weight. Thus, one skilled in the art would not have been motivated to combine the cited documents as suggested by the Examiner in order to prepare a weight reducing pet food.

There is also no suggestion of how to combine the cited documents in the manner necessary to arrive at the claimed invention. This suggestion must be found in the cited documents - and it is lacking. The Examiner suggested that one skilled in the art would have selected, 1) L-carnitine and chromium from Hastings; and 2) vitamin A and corn from Purina; and then substituted barley and/or sorghum from the disclosure of Nakatsu for the corn of Purina. It is respectfully submitted that the cited documents would not in any way guide one skilled in the art to make these selections. Only the instant application suggests the claimed beneficial combination of ingredients. It is respectfully submitted that the Examiner could only have arrived at the claimed combination in hindsight, with guidance from the instant application.

Thus the suggestion of how to combine the cited documents in the manner necessary to arrive at the claimed invention is lacking.

The cited references also do not establish a reasonable expectation of success. The references do not suggest that a pet food comprising a source of carbohydrates selected from sorghum, barley, and mixtures thereof would promote weight loss. The references do not suggest that any special advantages can be derived from sorghum and/or barley. Thus, they do not provide any reasonable expectation that a pet food composition comprising a source of carbohydrates selected from sorghum, barley, and mixtures thereof would have greater success in reducing weight than any other pet food composition.

The cited references also do not teach or suggest all the elements of claims 15-24. The claims recite a specific source of carbohydrates selected from sorghum, barley, and mixtures thereof. This specific source of carbohydrates is not identified in any of the cited documents. Rather, sorghum and barley are included in a list of solid feeds at column 5 of Nakatsu. This list includes other carbohydrates that do not have a low glycemic index. Thus, any combination of feeds from this list would not necessarily provide the weight reducing benefits of the combination recited by the instant claims. There is no guidance in any of the cited documents to select sorghum and/or barley over any other feed or grain.

Therefore, there is no motivation to combine the cited documents, and no suggestion in the cited documents to combine the disclosures in the manner necessary to arrive at the claimed invention. Additionally, the cited documents would not have provided one skilled in the art with a reasonable expectation that the claimed composition would have promoted improved weight loss. The cited documents also fail to suggest the carbohydrate source recited by the instant claims. Accordingly, it is respectfully submitted that none of the three elements necessary to establish a *prima facie* case of obviousness are present. Accordingly, withdrawal of the rejection under 35 U.S.C. §103 is appropriate. .

Additionally, even if a *prima facie* case of obviousness had been established, the instant claims recite a specific carbohydrate source that unexpectedly was found to provide improved weight loss (please see that specification at page 9). Example 1, at pages 7 and 8 of the application, reports the results of a comparative feeding study that was conducted using a

composition of the invention. At page 9, it is reported that “Diet B,” which comprises a low glycemic index carbohydrate source (sorghum and barley), produced more preferable weight loss. Thus, the instant claims recite a carbohydrate source that provides a benefit that is unexpected and not obvious from the disclosures of the cited documents. Therefore, even if a *prima facie* case of obviousness did exist, *arguendo*, the data provided in the specification at Example 1 would rebut the *prima facie* case of obviousness.

The Examiner cited *Ex parte Obiaya* (227 U.S.P.Q. 58, 60 (Bd. Pat. App. & Inter. 1985)) for the proposition that another advantage which would flow naturally from the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. Some of the claims involved in *Obiaya* were directed to a combustible fluid and oxygen concentration sensor involving a labyrinthine heater (*id.* at 60, first column). The applicant presented evidence that labyrinthine heaters allowed a shorter response time and argued this was an unexpected result (*id.* at 60, 2nd column). The court rejected this argument on the basis that the prior art already disclosed an advantage to using labyrinthine heaters—maintaining samples at a uniform temperature—thus specifically suggesting the use of labyrinthine heaters (*id.* at 60, right column). It is in this context that the court wrote, “The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious” (*id.* at 60, right column, emphasis added). In contrast, in the present case, the cited documents do not suggest any advantage to using barley or sorghum as opposed to other grains. Accordingly, the instant facts can be distinguished from the facts in *Ex parte Obiaya*.

In view of the remarks herein, Applicant respectfully requests withdrawal of the rejection of claims 15-24 under 35 U.S.C. § 103(a).

As a final matter, it is noted that claims 10-13 have been withdrawn from consideration. If composition claims 15-24 are found allowable, rejoinder of process claims 10-13 (to the extent that they recite the composition of claim 15 is hereby requested. M.P.E.P. §821.04

Conclusion

Applicant respectfully submits that the claims (10-13 and 15-24) are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-359-3265) to facilitate prosecution of this application.


If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

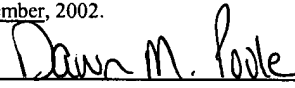
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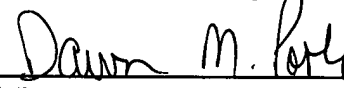
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